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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,170	02/13/2004	Leon A. Johnson JR.	21637.00	4463

7590

10/20/2004

Richard C. Litman
LITMAN LAW OFFICES, LTD.
P.O. Box 15035
Arlington, VA 22215

EXAMINER

SUHOL, DMITRY

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/777,170

Applicant(s)

JOHNSON, LEON A.

Examiner

Dmitry Suhol

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 10-12 is/are rejected.
- 7) ☒ Claim(s) 8 and 9 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/13/04</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 10-12, there is no antecedent basis for "the model contact lens". The independent claim does not recite any sort of contact lens while the dependent claims in the preamble refer to a variety of contact lenses (hard and soft), respectively therefore it is not clear if applicants are claiming a model contact lens being a hard one and a soft one in the respective claims or a plurality of contact lenses (i.e. a hard lens and a model contact lens) or is the claim dependency incorrect (since claims 7 and 9 teach a model contact lens). For purposes of examination it is assumed that applicants intend to claim a model contact lens which may be a hard or soft lens as recited in the respective claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Ostrander '826. Ostrander discloses an eye structure containing all of the elements of the claims including a cover (read onto cover formed by eye socket 41) having a front opening (opening 28) and a rear opening (col. 4, lines 5-8), a model eyeball (46) moveably contained within the cover (col. 3, lines 65+), the model eyeball having visual indicia of a human eyeball (cols. 3-4, lines 74-75 and line 1, respectively), an upper eyelid (36) attached to the front cover above the front opening (figures 1 and 3), a lower eyelid (40) attached to the cover below the front opening (figures 1 and 3), wherein the upper and lower eyelids are moveable between an open position and a closed position (figure 3 and 4 and col. 4, lines 1-5), and wherein the upper and lower eyelids in the open position define a visible surface of said eyeball (figure 1). Visual indicia of a human eyeball being visible on the surface when the eyelids are in the open position, as required by claim 3, is shown in figure 1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ostrander '826 in view of Chang '918. Ostrander discloses all of the elements of the claims, as stated above, but for the eyeball being generally spherical as required by claim 2 and explicitly teaching the eyeball comprising visual indicia of a pupil as required by claim 4. However, Chang discloses an eye structure which teaches that it is known to provide/manufacture the eyeball of such a structure with a generally spherical shape (figure 1, eyeball 30) as well as the eyeball having a pupil portion (33). Therefore it would have been obvious to one having ordinary skill in the art, at the time of the claimed invention to have incorporated the teachings of the eye structure of Chang, as stated above, with the eye structure of Ostrander for the purpose of providing an eye structure which is not dull and unattractive as well as a structure that is capable of easily rotatable movement, especially since Ostrander clearly states that the eye of his invention is representative of a human eye (cols. 3-4, lines 75 and 1, respectively, where a pupil is a well known portion of a human eye) and since Ostrander clearly states that his eyeball can be movable (col. 3, lines 71-73).

Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ostrander '826 in view of Lam et al '279. Ostrander discloses most of the elements of the claims, as stated above, but for explicitly teaching the eyeball comprising visual indicia of a pupil as required by claim 4, an iris as required by claim 5, and a sclera as required by claim 6. However, Lam discloses an eye structure which teaches that it is known manufacture such eyes with a pupil (130), an iris (140) and a sclera (110 and

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page 1, paragraph 0019). Therefore it would be obvious to manufacture the eyeball portion of Ostrander with a pupil, iris and sclera for the purpose of providing an attractive and realistic eyeball, especially since Ostrander clearly states that the eye of his invention is representative of a human eye (cols. 3-4, lines 75 and 1, respectively, where a pupil is a well known portion of a human eye).

Claims 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ostrander '826 in view of Dean '595. Ostrander discloses most of the elements of the claims, as stated above, but for explicitly teaching the eyeball comprising visual indicia of a pupil as required by claim 4, an iris as required by claim 5, a sclera as required by claim 6 and a removable model contact lens as required by claim 7. However, Dean discloses a device like that of Ostrander which teaches that it is known manufacture such a device with an eye structure with a pupil (24), an iris (25) and a sclera (surround portion around the iris of the eyeball as shown in figure 3) along with providing removable contact lenses (30) with such a device. Therefore it would be obvious to manufacture the eyeball portion of Ostrander with a pupil, iris and sclera for the purpose of providing an attractive and realistic eyeball. It would have further been obvious to provide the device (doll) of Ostrander with removable contact lenses for the purpose of changing eye color.

Allowable Subject Matter

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Claims 8-9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 10-12 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dmitry Suhol whose telephone number is 703-305-0085. The examiner can normally be reached on Mon - Friday 9am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 703-308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Dmitry Suhol
Dmitry Suhol